

### Remarks

Applicants request favorable reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1, 3, 4, 7, 9-12, 27-29, 31-33, 38, and 42-56 are pending in this application, with Claims 1, 27-29, 31, 38, 42, 46, 48, 51, and 54-56 being independent.

Claims 1, 27-29, 31, 38, 42, 46, 48, 50 and 51 have been amended. Claims 54-56 are newly presented. No new matter is believed to have been added.

Formal drawings are submitted herewith as required.

Claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38, and 42-53 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,029,182 (“Nehab”). Claims 32-33 have been rejected under 35 U.S.C. § 103(a) as being obvious over Nehab in view of U.S. Patent No. 5,633,996 (“Hayashi”). These rejections are respectfully traversed.

Applicants submit that the invention as presently defined in the amended claims is distinguishable over Nehab. The Examiner asserts that Nehab does not explicitly disclose “monitoring a second application operating independently of said first application on said local machine, to identify the plurality of hyper-text documents accessed by the second application.” Applicants submit that, contrary to what is stated in section 7 of the Office Action, Nehab does not suggest this express feature of the present claims.

Further, in relation to the present amendments to the claims, Applicants submit that Nehab is silent as to either of the “applications” therein having direct access to Web documents. Both must operate via the web reader. This is in contrast to the present invention in which user access is via a traditional browser, and the monitoring enables a

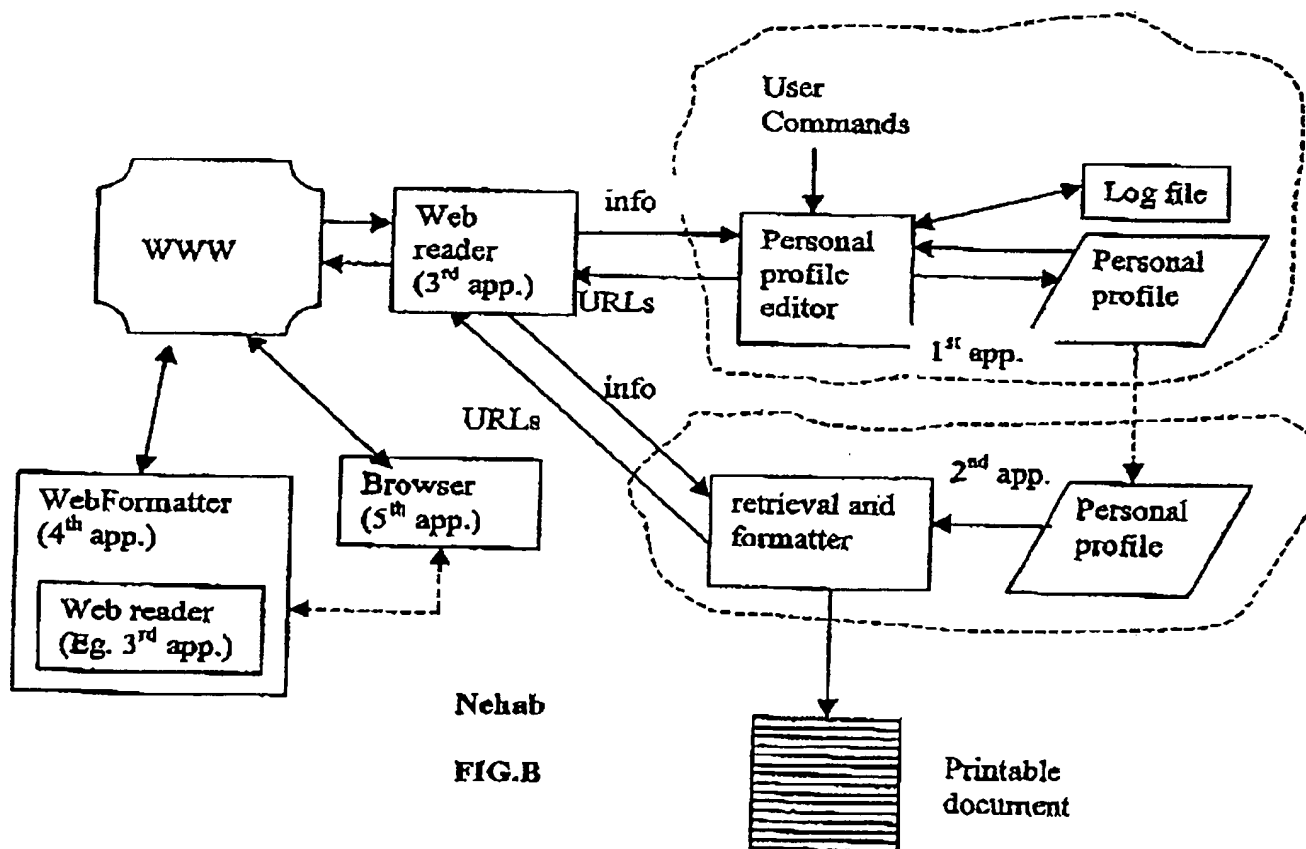
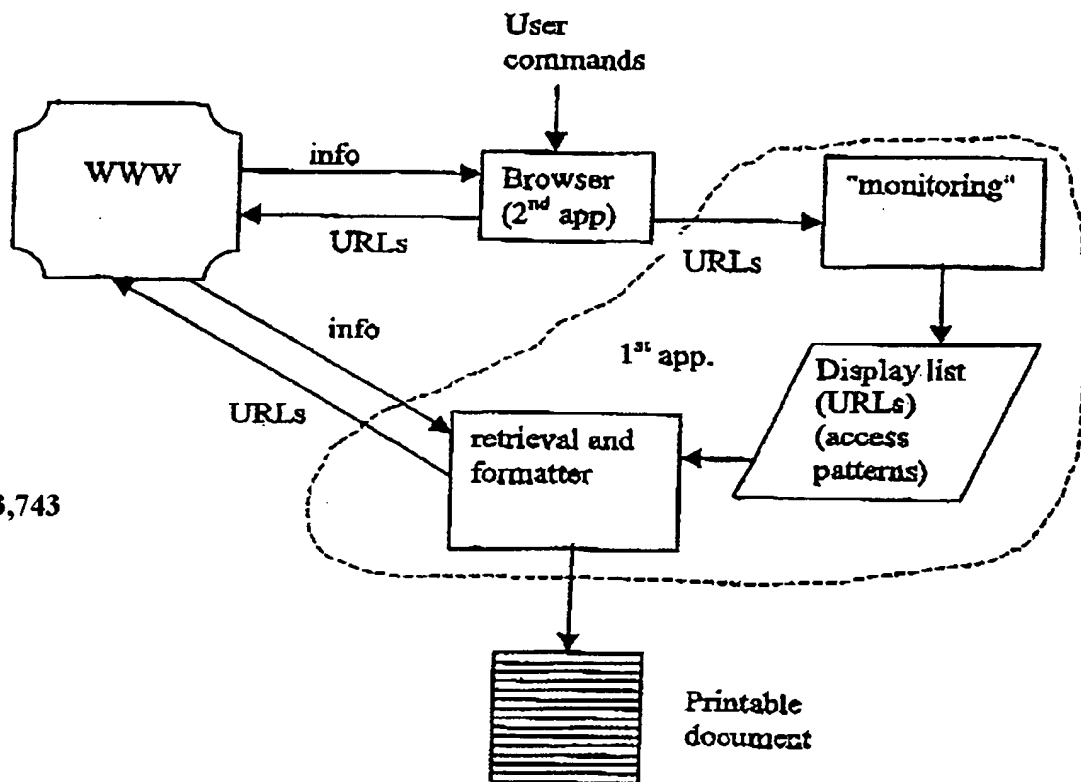
printing application to directly access Web documents independent of operation of the browser.

In view of the continued rejection over Nehab, Applicants have again carefully reviewed that patent. With reference to the comparative illustration submitted in the July 22, 2003 Amendment, Applicants submit that they have previously and unintentionally misinterpreted Nehab by reading more into the patent than should have reasonably been construed from the disclosure thereof. In this regard, Applicants previously construed the “web reader 34” of Nehab to be essentially like a “browser” as interpreted in the present application. However, in light of the Examiner’s comments regarding “the browser,” at the top of page 4 of the Office Action, Applicants now consider Nehab’s web reader 34 to be a distinct device. As a consequence, Applicants now submit a revised illustration (page 21 of this Amendment) comparing the present invention with Nehab. Support for this interpretation and the revised illustration are as follows:

1. Nehab discloses an arrangement (see Fig. 2) which comprises two separately executable applications (the personal profile editor 16 of Fig. 4, the web printer 17 of Fig. 6), each of which is able to work in concert with a further application (a web reader) to achieve printing of a web-based document.
2. Nehab also discloses in the arrangement (of Fig. 2) an HTML formatter 18 which may be exemplified by a proprietary product WebFormatter (see col. 13, line 14). Col. 13, lines 21-29 states that such may be used in conjunction with various known Web browsers of the type mentioned in the present application. Col. 18, lines 41 to col. 19, line 52 and particularly at col. 18, lines 65-66, states that part of WebFormatter executes a “web reader similar to that of web reader 34 described above.”

A/N 08/903,743

FIG. A



Nehab

FIG.B

3. As a consequence, through the express language of the patent, Nehab distinguishes the web reader from a “browser.” It follows therefore that the changes to the previous comparative illustration will assist in identifying the similarities and differences between the present invention and the disclosure of Nehab.

The method of Claim 1 operates as part of a “first” application which monitors operations of a “second” and independent (browser) application. Having performed the monitoring, the first application then compiles a list of locations (i.e., documents) visited using the second application and then, independently of operation of the second application, fetches those documents to generate a single contiguous printable document.

A “first” application as clearly described by Nehab operates to create and maintain a personal profile of web locations of interest to the user. Nehab’s “second” application makes use of the established personal profile to retrieve information to then create a printable linear document. Nehab, as clearly seen from the new comparative illustration, requires a third application (the web reader) to facilitate web access for each of the first and second applications and, as discussed above, discloses further applications (WebFormatter that operates in conjunction with a web browser) to perform additional tasks.

Applicants respectfully submit that, contrary to what is stated in the Office Action, nowhere does Nehab disclose or suggest any arrangement whereby the monitoring of the user’s access via the browser can be used to directly form the printable document. In this regard, reference is made to the following portions of the patent specification of Nehab:

Column 3, lines 17-18, “a stored personal-news-profile is retrieved.”

Column 3, lines 32-34, “a web site data retrieval driver which includes a web reader, stored web site address information, stored web site commands, and stored format instructions is accessed.”

Column 3, lines 52-55 “the invention connects to the world wide web, retrieves user defined web site address information, user defined web site commands, and user defined formatting commands, and activates a web reader so as to access a web site based on the user defined web site address information.”

Col. 4, lines 1-8, “the invention stores a personal-news-profile... (and) retrieves the stored personal-news-profile and accesses the data stored therein, activates a web reader to contact a website based on address data stored in the personal-news-profile....”

Column 4, lines 13-14, “a location of the hypermedia document is specified.”

Column 4, lines 27-33, “the system accesses the hypermedia document, extracts addresses from the hypermedia document, and stores the addresses extracted from the hypermedia document in a container. The system activates a processing function to process data stored at the addresses stored in the container, downloads the data stored at the addresses stored in the container into a memory, and extracts predetermined data from downloaded data in accordance with predetermined configuration information.”

Applicants submit that the above-quoted sections all clearly support the understanding that in Nehab, the personal profile must first be concretely established (by way of its own application), and this establishment is a clear precursor to the subsequent (and periodic) retrieval and formatting of a printable document to form a “personal newspaper” or the like.

Applicants submit that in Nehab, the personal profile editor has two basic functions, those being:

- (a) to receive input from the user via a graphical user interface to thereby enable the web reader to access web locations/documents; and

(b) to interpret the web locations either automatically or under user control to create the personal profile.

Applicants further observe the following passages:

Col. 4, lines 39-41, “the system inputs the formatting settings and configuration information via a graphical user interface.”

Col. 4, lines 54-57, “by displaying the graphical user interface in plural modes, the present invention facilitates operation of the invention during browsing of the hypermedia document.”

The invention of Nehab, as discussed above and according to Nehab’s summary, requires two distinct steps, these being profile formation and a subsequent step of retrieval/formatting. As such, the second reference to “invention” in col. 4, lines 54-57 is interpreted to mean:

...the present invention facilitates creation of the personal profile during browsing of the hypermedia document...

Further, such “browsing” is not to be interpreted as browsing using a stand-alone browser as noted above and in the comparative illustration, but rather an analogous user function via the personal profile editor for the purpose of creating the personal profile. As seen in the comparative illustration, in the present invention, the user operationally interacts with the browser (the second application) while the document generator (first application) operates in a background mode to the browser. In Nehab, the user interacts directly with the personal profile editor which is an essential and distinct part of Nehab’s document creation process. While with the present invention, a user can adjust printable document features, such as the documents in the print list and formatting features of a

document, such are ancillary to the present invention where document generation is automated from an independent monitoring of a separate (browser) application.

This interpretation is generally supported elsewhere in Nehab at col. 7, line 57 to col. 8, line 67 and particularly at col. 8, lines 39-45 where Nehab states that the:

“...site driver 36 maintains a hierarchical log of web sites visited by web reader 34. In step S507, personal-news-profile editor 16 creates an extraction rule from the web command. This rule will allow the news retrieval system to later duplicate the user’s selection criteria in browsing (clicking on hyper links within) a web site.”

This mentioning of the “hierarchical log” is believed to be that which the Examiner considers to make obvious the specific monitoring step that has been acknowledged as being absent. With respect, Applicants submit that the hierarchical log mentioned in col. 8 and quoted above is nothing more than a list of web sites visited by the web reader 34 and which is maintained by site driver 36 of the personal-news-profile editor 16.

Applicants have carefully reviewed the remainder of Nehab and have been unable to locate any express or implicit disclosure as to how this “hierarchical log” is used, without intervention by the user, for the retrieval and formatting of linear web documents. From such, one of ordinary skill in the art can only infer that the hierarchical log can only be used to create the personal profile discussed above and as depicted in the comparative illustration.

In this regard, Applicants submit that there is a significant advance contained in the present application which is not taught or suggested by Nehab. In Nehab,

irrespective of the manner in which the personal user profile is formed, it is quite clear that the profile must be established in some way prior to retrieval and document formatting taking place. There is no disclosure or suggestion in Nehab that such processes may be combined and can operate in a unitary fashion. Attention is specifically drawn to col. 10, lines 37-39 where Nehab states:

“Once a personal-news-profile 19 has been created, the web news retrieval system, upon being launched, can traverse web news sites and build a personalized newspaper....” (emphasis added)

It follows that the conclusion reached in section 7 of the Office Action is one that can only be arrived at with the aid of hindsight upon having read the present application, and is not a conclusion that would ordinarily flow from a reading of Nehab.

Further, the Office Action at section 7 states that:

“...Nehab teaches the duplication of the user’s selection criteria in clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides a benefit of automatically, and interactively monitoring user’s selection of hyperlinks....”

Applicants submit that, while Nehab’s “hierarchical log,” as discussed above, can track where a user goes, Nehab requires further processing by the personal profile editor before the personal profile is created. Only then may the personal profile be subsequently used to create the printable document. Significantly, the “benefit” suggested in the Office Action is not one that is taught by Nehab, and in view of the disparate processes being performed as exemplified in the comparative illustration, is not one that is readily appreciable from Nehab. This is because Nehab requires the “profile” to be



“personal” and concretely established prior to document generation, and not generated on the fly, so to speak, for immediate use as can be done with the present invention.

Applicants submit that it follows that the alleged “benefit” is one that has only been gleaned with the aid of hindsight, having read the present application, and such is not sufficient to render the invention obvious.

Applicants respectfully submit that, as a consequence, the § 103 rejection as set out in section 7 of the Office Action is improperly founded. Because the features discussed above are to be found in the claims mentioned in section 7 of the Office Action, such are similarly addressed. This is particularly the case in respect of independent Claim 27, in which the feature relied upon in the Office action corresponds to that relied upon with respect to Claim 1.

Regarding the rejection of Claim 48, amendments have been made to Claim 48 to bring it in line with Claim 1. Applicants submit that Claim 48 therefore patentably distinguishes the invention over Nehab for corresponding reasons. Nehab, as noted in the Office Action, fails to explicitly disclose “displaying the list of the plurality of documents.” This is quite correct because, with Nehab, there is no such need to display any such documents. In Nehab, the user, quite independently of the document retrieval, creates such documents. The user, quite independently of the document retrieval, creates his or her own personal profile which is subsequently used to generate a formatted document. As a consequence, the user knows what he or she intends to retrieve, and there is therefore no need, during the performance of the retrieval operations, to display any such list to the user.

Further, such would be of little use if the retrieval/formatting is performed as a periodic batch process.

Claim 48 recites at least one other feature that distinguishes the invention over Nehab. In this regard, Nehab is concerned with the routine retrieval of data from predetermined locations where the data varies according to time. This is always the case with periodicals such as newspapers and the like. What Nehab establishes are predetermined criteria for newspaper retrieval and, having established certain rules in the personal profile editor, Nehab can then operate on a regular basis (for example, daily), to create a personal daily edition of a newspaper.

In contrast, the present invention is concerned with monitoring a user's browsing session on the Internet and updating and maintaining a printable record of those locations traversed by the user. As a consequence, in the present invention, the monitoring takes place coincident with the traversal, with the formatting of the document continuing in a background mode. In this fashion, the document paths encountered can "chop and change" (change constantly) to indicate a user's movements during a browsing session. This is in contrast to Nehab, in which sections of information are pre-specified by the user for subsequent retrieval. In Nehab, the user knows what he/she is to see and can therefore edit and tailor personal preferences accordingly. In the present invention, the user does not know where he/she is going and as such, a list is displayed to enable the user to edit the list to discard those items not desired to be printed. In this instance, however, and as distinct from Nehab, the removal of documents from the list is consequential to the inclusion of the documents on the list and in the printable document. In the arrangement of Nehab,

documents not desired never appear in the list nor do they ever appear in the printable document. This is because Nehab has a different fundamental purpose, namely, that of providing a personalized periodical newspaper from a personal profile.

In respect of Section 8 of the Office Action, Applicants submit that since Claims 32 and 33 are dependent upon Claim 1, such are also non-obvious as discussed above.

Regarding new method Claim 54, and corresponding apparatus and computer medium Claims 55 and 56, such have been presented to further define how the present “monitoring” operates independently. These claims define the “monitoring” of the second application operating independently of the first application on the local machine, to create a print list related to the plurality of hyper-text documents accessed independently by the second application. Applicants submit that, significantly, the recited feature of the monitoring’s adding information of newly accessed documents to the print list according to the second application’s accessing of those documents is not taught or suggested by Nehab. Further, the “fetching” step of Claim 54, in its combination with the “monitoring” and “formatting” in a first application is never taught or suggested by Nehab.

According to § 706.02(j) of the MPEP, “to establish a *prima facie* case of obviousness, three basic criteria must met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991).”

Regarding these points, Applicants submit that Nehab makes no suggestion and provides no motivation for modifying the teachings therein to correspond with the teachings of the claimed invention. Nehab is silent of any need to have one application monitor another independently operating application. Also, there is no indication that Nehab could operate in the fashion defined by the present invention, thus preventing any reasonable expectation of success. Arguably, there is nothing to suggest that a review of Nehab would reveal the totality of the present invention. This is because Nehab is entirely silent of “first” and “second” independent applications with any “monitoring” therebetween. As to the third criteria, Applicants have pointed out where the relied upon combination of prior art fails to teach or suggest each claimed limitation.

As to Hayashi, Applicants submit that it fails to remedy the discussed deficiencies of Nehab, whether taken alone or in combination with Nehab.


Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103 rejections.

Applicants submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons that the base claims from which they depend are allowable, and further due to the additional features that they recite. Individual consideration of each of the dependent claims is respectfully requested.

Applicants submit that the present application is in allowable form. Favorable consideration of the claims and passage to issue of the present application at the Examiner's earliest convenience are solicited.

Applicants' undersigned attorney may be reached in Washington, D.C. by telephone at (202) 530-1010. All correspondence should continue to be directed to the below-listed address.

Respectfully submitted,

  
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